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In re Application of: Jean-Louis H. Gueret :  
Appl. No.: 09/809,268 : DECISION ON PETITION  
Filed: March 16, 2001 :  
For: Product Applicator and Packing Unit Comprising :  
Such Applicator :

This is a decision on the petition filed on July 23, 2003 by which petitioners request supervisory review of, and reconsideration and reversal of the examiner's withdrawal of claims pursuant to an election of species requirement as set forth on July 8, 2002, traversed by petitioners on Jan. 22, 2003, and *made final* in the Office action of October 22, 2002. The petition is considered pursuant to 37 CFR 1.144 and 37 CFR 1.181, and no fee is required.

The petition is granted.

A review of the prosecution history shows that:

1. As filed, this application contained claims 1-22 which were cancelled and replaced with claims 23-222 by the preliminary amendment filed on 3/16/01.
2. On July 8, 2002, the examiner promulgated a requirement for election of species<sup>1</sup> of Figs. 1-8.
3. In response to the examiner's election of species requirement, on Aug. 7, 2002, the applicant has elected Fig. 4 and indicated claims 23-34, 36-39, 41-62, 64-69, 71, 72, 82-108, 110-115, 117, 118, 128-154, 156-161, 163, 164, 174-203, 205 and 214-222 were directed to the elected species of Fig. 4.
4. On Oct. 22, 2002, the examiner promulgated a first action on the merits only for claims 136, 137, 146, 148-152, 156, 161, 163, 174, 175, 179 and 189-190. The examiner further held that the

<sup>1</sup> It is noted that the most recent version of the MPEP dated August 2005 has been revised to include a requirement for the examiner to specifically address the issue of serious burden should either an election of species between independent inventions or a restriction between independent or distinct inventions be made. This however was not the procedure proscribed by the MPEP at the time of issuance of the original requirement herein.

elected claims 23-135, 138-145, 147, 153-155, 157-160, 162, 164-173, 176-178, 180-188 and 191-222 do not read on the elected species of Fig. 4.

5. In response, on Jan. 22, 2003, petitioner filed a request for re-consideration of the withdrawal of claims 23-135, 138-145, 147, 153-155, 157-160, 162, 164-173, 176-178, 180-188 and 191-222 and the traversal of the rejection of claims 136, 137, 146, 148-152, 156, 161, 163, 174, 175, 179 and 189-190.

6. On April 23, 2003, the examiner responded to the request for re-consideration by promulgating a final rejection. In the final rejection, the examiner also repeated the restriction requirement and made final.

7. On July 23, 2003, the petitioner filed the current petition requesting supervisory review of, and reconsideration and reversal of the examiner's withdrawal of claims 23-34, 36-39, 41-62, 64-69, 71, 72, 82-108, 110-115, 117, 118, 128-135, 138-145, 147, 153, 154, 157-160, 164, 176-178, 180-188, 191-203, 205 and 214-222.

#### Relevant Disclosed Inventions

A review of the application and of the claims shows that the claimed invention is an apparatus for powdery or pasty product and method to apply a cosmetic product to a surface region. The invention relates to the application of a make-up product such as eye shadow, cheek blusher, make-up foundation, eyeliner, a nail-care product, liquid lip rouge, loose powder, paints, adhesives, pasty or other liquid product, by using a sandwich-type applicator. The sandwich-type product applicator is made of a semi-rigid support including at least one soft spongy material. The support has an applicator portion and a gripping portion. The gripping portion is covered, at least in part, by at least one layer of a first soft spongy material the flexibility of which is greater than the flexibility of the support. Applicator portion is made of either a tuft of bristles, a pencil brush, a feather, a sponge, a baize material or a foam end fitting fixed to a gripping portion such as a rigid plastic handle. The applicator portion may be a portion of the support covered, at least in part, by at least one layer of a second soft spongy material. The first and the second materials may be identical or different. These materials are identical and are formed of a material chosen from foams of polyurethane, polyester, polyether, polyvinyl chloride or polyethylene. The first and/or the second spongy material fixed to one side of the applicator may be a leakproof foam with closed cells. This material makes it possible to obtain an applicator having one side impervious to the product. At least one of the spongy materials may be flocked or covered with a fabric or a silicone layer. The spongy materials may be impregnated with active cosmetic agents, anti-bactericidal agents, fungicides and agents filtering ultraviolet radiation. The support may have at least two parallel sides, which allows the applicator to be held more easily between the fingers. The support may be made of cardboard, plastic, leather, or a foam that is more rigid than the first and second spongy materials. The applicator may have any shape. It may take the form of a strip of uniform width, or one having a thin portion and a wide portion, or even the form of a puff. The wide portion may have, as viewed from above, a polygonal or circular shape. The puff may have a polygonal, square or circular shape. The applicator may have a median axis parallel to the parallel sides of the support and the applicator portion. The gripping portion may be symmetrical relative to this median

axis. The first spongy material may be fixed to one of the sides, or to the two sides, of the support. The second spongy material may be fixed to one of the sides or to the two parallel sides. The first and second materials are fixed to the same side of the support. The applicator may have on the same side one or several layers of a spongy material that are identical or different, both as regards the gripping portion and the applicator portion. Thus the flexibility of the applicator portion and of the gripping portion may be identical or different. In particular, it is possible to use spongy materials which are incompatible with one another and which cannot be welded directly to one another. In this case, the materials are bonded to the support, and possibly to one another in the case of multilayer materials. Moreover, the layer or layers of the first and second materials may be joined or separated in a plane parallel to the sides of the support. The applicator may have one or several cutouts traversing the support and the first and/or second materials from one side to the other, i.e., through its thickness. This cutout or cutouts may be in the gripping portion and/or the applicator portion. It has the effect of modifying the flexibility of the support of the applicator. In particular, when the cutout is in the gripping portion, the softness of the gripping fingers is increased. The user may hold the rigid handle of the applicator, impregnate the applicator portion with the make-up product and place the impregnated applicator portion into contact with the skin to be made up, e.g. the eyelid or the cheek.

Four embodiments on different applicators appear to be disclosed and illustrated as Figs. 1-4, respectively. Figs. 5-7 illustrate various shapes of the four embodiments on different applicators. Fig. 8 illustrates a packaging unit for the applicators.

#### Readability of Non-Elected Claims

The examiner in his office action of Oct. 22, 2002 held that the claims 23-135, 138-145, 147, 153-155, 157-160, 162, 164-173, 176-178, 180-188 and 191-222 do not read on the elected specific of Fig. 4 because these claims are not generic. There is no support found in the elected species of Fig. 4. Particularly, the examiner specifically stated that claim 23 requires that the material of gripping portion covering the second end of the flexible support be impervious to a cosmetic product as disclosed the only material being described as impervious is material 16b which in the species of Fig. 4 is not covering a second end of the flexible support which is part of the gripping portion 6. The examiner further stated that claim 24 requires that the flexible support be cardboard and species of Fig. 4 does not disclose or show.

The bulk of Petitioner's position that the claims 23-135, 138-145, 147, 153-155, 157-160, 162, 164-173, 176-178, 180-188 and 191-222 do read on the elected specific of Fig. 4. In particular, the petitioner argued that the various claimed elements are exemplary feature and generic to all disclosed embodiments.

#### Analysis of the Record in This Application

As noted in MPEP 2111, 2111.01, during patent examination, claims are given their broadest reasonable interpretation consistent with the specification.

A careful review of the Summary of The Invention reveals that the support of claim 23 can be found on Page 3, lines 24-26 and page 5, lines 3-6. The spongy material for elements 16c, 16d is

impervious to the cosmetic product. These claimed flexible materials are generic to all disclosed embodiments.

Claim 23. A layered product applicator 1 comprising: an applicator portion 4 comprising a first end of a flexible support, said application portion being configured to apply a cosmetic product; and a flexible elongated gripping portion comprising a second end of the flexible support 2 and at least one layer of a flexible material (16c or 16d) covering the second end (at 6) of the flexible support 2, the flexibility of said material of said at least one layer being greater than the flexibility of the support 2, said flexible material 16c, 16d being impervious to the cosmetic product.

With regard to claim 24, the support can found on page 4, lines 10-12 and page 7, lines 15-16. Again, the flexible support 2 comprises cardboard in claim 24 is generic to all embodiments.

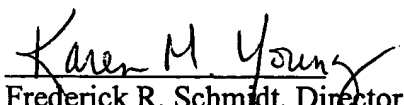
Claim 24. A layered product applicator comprising: an application portion 4 comprising a first end of a flexible support 2; and a flexible elongated gripping portion 6 comprising a second end of the flexible support 2 and at least one layer of a flexible material 16c or 16d covering the second end of the flexible support 2, the flexibility of said material of said at least one layer being greater than the flexibility of the support, wherein the flexible support comprises cardboard 2.

Based on the similar analysis as applied to claims 23, 24 for the remainder claims, Petitioner correctly opined on pages 5-15 of the Petition that all claimed elements as set forth in claims 26-34, 36-39, 41-62, 64-69, 71, 72, 82-108, 110-115, 117, 118, 128-135, 138-145, 147, 153, 154, 157-160, 164, 176-178, 180-188, 191-203, 205 and 214-222 are exemplary features to all disclosed embodiments.

For the reasons as stated above, claims 23-34, 36-39, 41-62, 64-69, 71, 72, 82-108, 110-115, 117, 118, 128-135, 138-145, 147, 153, 154, 157-160, 164, 176-178, 180-188, 191-203, 205 and 214-222 must be rejoined and examined. Accordingly, the withdrawal of claims 23-34, 36-39, 41-62, 64-69, 71, 72, 82-108, 110-115, 117, 118, 128-135, 138-145, 147, 153, 154, 157-160, 164, 176-178, 180-188, 191-203, 205 and 214-222 from consideration by the examiner is hereby vacated.

The application is being forwarded to the Supervisory Patent Examiner of Art Unit 3732 who will have the examiner promulgate an action on the merits of the presently pending claims 23-34, 36-39, 41-62, 64-69, 71, 72, 82-108, 110-115, 117, 118, 128-135, 138-145, 147, 153, 154, 157-160, 164, 176-178, 180-188, 191-203, 205 and 214-222 not inconsistent with this Decision.

PETITION GRANTED

for   
Frederick R. Schmidt, Director  
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